



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/579,535

05/16/2006

Takashi Mori

Q94763

8478

65565 7590 04/03/2009  
SUGHRUE-265550  
2100 PENNSYLVANIA AVE. NW  
WASHINGTON, DC 20037-3213

EXAMINER

HANRAHAN, JOSEPH M.J.

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

04/03/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/579,535	<b>Applicant(s)</b> MORI ET AL.	
	<b>Examiner</b> JOSEPH M.J. HANRAHAN	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 5, 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: ____.                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :12/29/08, 8/1/08, 8/24/06, 5/16/06.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 5 and 10 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim *cannot depend from another multiple dependent claim*. See MPEP § 608.01(n). The claims have been further treated on the merits, but failure to correct the deficiency will result in the claims being withdrawn from consideration.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3, 5, 8, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "excellent" in claims 5 and 10 is a relative term which renders the claim indefinite. The term "excellent" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what exactly "excellent" would mean in terms of form retention property.

5. The phrase, "allowing any one of the fish meat protein molded into a fibrous form by acid denaturation," found in Claims 3 and 8 does not have any meaning because the

Art Unit: 1794

statement is incomplete. When this statement is read the reader is not informed what the fish meat protein molded into a fibrous form by acid denaturation is allowed to do.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1794

**9. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura (US Pat. No. 4584204) in view of Okada (US Pat. No. 4559236).**

10. Nishimura teaches a process of combining fibrous fish meat protein with fish meat paste to create a fibrous fish meat-bound food product which is then molded and heated to bind the fibers and meat paste (Nishimura Col. 3, Lines 35-45). Nishimura also discloses an 80:20 ratio of fish meat protein to meat paste. Nishimura, however, does not disclose creating the fish protein fibers by acid denaturation or adjusting the pH to a range of 6.5 to 7.5.

11. Okada teaches creating fish protein fibers by acid denaturation (Col. 3, Line 63 – Col. 4, Line 19) and subsequent acid neutralization (Okada Col. 4, Line 35-40).

Furthermore, Okada teaches that fish protein fibers may be molded and heated (Okada Col. 4, Lines 40-50). The examiner notes that Okada teaches, at Col. 4, Line 35-40, that the remaining acid may be neutralized. Neutral solutions are at a pH of about 7.0 which is within the claimed range.

12. Together, the Nishimura and Okada references teach all the steps of the presently claimed invention. As shown above, they teach creating a fibrous fish meat protein, molding and heating the fibrous fish meat protein, mixing a fibrous fish meat protein with fish meat paste to create a composite, the molding and heating of the composite, and adjusting the pH to a range of 6.5 to 7.5. It is obvious to rearrange those steps as they are in Claims 1-3.

13. It would have been obvious to a person skilled in the art at the time of invention to have combined the fibrous fish-meat of Okada with the process of creating a fish

Art Unit: 1794

meat composite of Nishimura. The motivation to do so would have been to create a process that results in a product that has excellent flavor and texture (Okada Col. 2, Line 23).

**14. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura (US Pat. No. 4584204) in view of Okada (US Pat. No. 4559236) and further in view of Okada (US Pat. No. 4880654).**

**15.** Nishimura and Okada teach the limitations of Claims 6-10 for the same reasons they teach the limitations of claims 1-5, as described above. However, Nishimura in view of Okada does not teach drying the fibrous fish meat-bound food. Okada 4880654 teaches drying a fibrous meat bound food (Col. 7, Lines 1-2). It would have been obvious to a person skilled in the art at the time of invention to have combined the drying step as taught in Okada '654 with the method taught by Nishimura in view of Okada '236. The motivation to do so would have been to create a jerky type product (Okada '654 Col. 7, Lines 5-6).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH M.J. HANRAHAN whose telephone number is (571) 270-7060. The examiner can normally be reached on M-F from 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R. Sample/  
Supervisory Patent Examiner, Art Unit 1794

/JOSEPH M.J. HANRAHAN/  
Examiner, Art Unit 1794